

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KAZUHIKO SUZUKI, WATANABE TAKAYUKI,  
YASUHIRO KITAHARA and MASANOBU AJIOKA

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Appeal No. 1997-4255  
Application 08/443,672

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HEARD: January 9, 2001

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Before WINTERS, ROBINSON, and GRIMES, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 5 and 7, which are all of the claims remaining in the application.

### REPRESENTATIVE CLAIM

Claim 7, which is illustrative of the subject matter on appeal, reads as follows:

7. A process for forming a molded product from a sheet of poly-L-lactic acid by vacuum forming, pressure forming or vacuum-pressure air forming, comprising the steps of

(a) holding a poly-L-lactic acid transparent sheet at holding temperature  $T_1$  for  $m_1$  minutes, wherein  $T_1$  is in the range of 55-90EC and  $m_1$  satisfies the formula:

$$\log_{10} m_1 < -0.083 T_1 + 7.66$$

(b) adhering the sheet to an internal surface of a mold through vacuum suction, compressed air pressure or vacuum/air pressure at mold temperature  $T_2$  which is in the range of from the glass transition temperature  $T_g$  of the poly-L-lactic acid to  $T_1$ , and

(c) removing a molded product having a haze of 5%/2 mm or less from the mold after reducing an internal temperature of the mold to less than said temperature  $T_g$ .

### THE PRIOR ART

The single prior art reference relied on by the examiner is:

Sinclair et al. (Sinclair)

WO 92/04413

March 19, 1992

### THE ISSUE

The issue presented for review is whether the examiner erred in rejecting claims 5 and 7 under 35 U.S.C. § 103 as unpatentable over Sinclair.

### DELIBERATIONS

Our deliberations in this matter have included evaluation and review of the following materials:

- (1) the instant specification, including all of the claims on appeal;
- (2) applicants' main brief and reply brief;
- (3) the examiner's answer;
- (4) the Sinclair reference;
- (5) the Suzuki declaration executed March 20, 1995; and
- (6) the Suzuki declaration executed April 17, 1995.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejection under 35 U.S.C. § 103.

### DISCUSSION

This is not a close case. The examiner argues that Example 72B of Sinclair suggests applicants' process for forming a molded product from a transparent sheet of poly L-lactic acid, including steps (a), (b), and (c) recited in independent claim 7. We disagree.

In our judgment, the examiner has not established that the starting material in Example 72B of Sinclair is a transparent sheet of poly-L-lactic acid. On the contrary,

Example 72B begins with “The poly(L-lactide) from Example 57B.” Turning to page 112, lines 12 through 25 of Sinclair, we find that the poly(L-lactide) recovered in Example 57B is transparent but not in the form of a sheet.

Furthermore, the first step in Example 72B of Sinclair describes melting and mixing the poly(L-lactide) from Example 57B on an open 2-roll mill for five minutes at 190EC. This is quite different from claim 7, step (a), which recites holding a poly-L-lactic acid transparent sheet at temperature  $T_1$  for  $m_1$  minutes, wherein  $T_1$  is in the range of 55-90EC and  $m_1$  satisfies a specified formula. On this record, the examiner has not established that it would have been obvious to go from “here to there,” i.e., from the melting and mixing step described by Sinclair at 190EC to the holding step recited in claim 7(a) at 55-90EC.

For the foregoing reasons, we conclude that the examiner has not established a prima facie case of obviousness of claims 5 and 7 based on the disclosure of Sinclair. Accordingly, we find it unnecessary to discuss the objective evidence of non-obviousness in appellants' specification, the Suzuki declaration executed March 20, 1995, or the Suzuki declaration executed April 17, 1995, relied on by the applicants to rebut any such prima facie case.

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The examiner's decision is reversed.

Sherman D. Winters  
Administrative Patent Judge

Douglas W. Robinson  
Administrative Patent Judge

Eric Grimes  
Administrative Patent Judge

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